



PATENT
Customer No.: 22,852
Attorney Docket No. 05725.0878-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL *et al.*

Application No.: 09/820,934

Filed: March 30, 2001

For: HEAT ACTIVATED DURABLE
CONDITIONING COMPOSITIONS
COMPRISING C₁ TO C₂₂
SUBSTITUTED C₃-C₅
MONOSACCHARIDES AND
METHODS FOR USING THE
SAME

Group Art Unit: 1615

Examiner: L. Channavajjala

Confirmation No. 4153

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER BOARD RULE § 41.41

Pursuant to Board Rule 37 C.F.R. § 41.41, Appellants present a Reply Brief to the Examiner's Answer dated January 26, 2006. This Reply Brief is due by March 26, 2006, and is timely. A Request for Oral Hearing is filed concurrently with this Brief.

REMARKS

Appellants' gratefully acknowledge the Office's indication that the obviousness-type double patenting rejection of claims 1-9, 13-19 and 29-59 is withdrawn in view of the Terminal Disclaimer filed July 18, 2005. (Ex. Answer at 3.) Appellant's also acknowledge with appreciation the Office's indication that claims 29-32 and 43-55 would be allowable if rewritten in independent form. (Ex. Answer at 2.)

In response to Appellants' Appeal Brief filed October 31, 2005, the Office maintains its position that claims 1-9, 13-19, 29-31, 33-42, and 56-59¹ stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,495,498 to Niemiec et al. (Niemiec) and U.S. Patent No. 5,688,930 to Bertho et al. (Bertho). (Ex. Answer at 3.) Appellants respectfully continue to disagree for the reasons of record, as emphasized below.

In the rejection of record, the Office points to Polyquaternium-10 as an example of the "at least one compound comprising at least two quaternary ammonium groups" recited in the claims. In the Examiner's Answer, the Office states that "Neimeic specifically teaches the claimed Polyquaternium-10 as the suitable and useful cationic cellulose derivative (col. 6, lines 2-7) and not as one out of several possible cationic conditioning agent." (Ex. Answer at 5.) The cited passage in Niemiec, however, at best teaches that, *if* the ordinary artisan were to select a cationic cellulose derivative as the class of cationic conditioning agent, *then* Polyquaternium-10 is a suitable cellulose derivative. Appellants again note that to arrive at Polyquaternium-10, the ordinary

¹ Based upon the Office's indication in the Status of Claims section, claims 29-31 appear to have been inadvertently included in the statement of the rejection under 35 U.S.C. § 103(a).

artisan would have to first select cationic cellulose conditioning agents from among other classes of cationic conditioning agents, then select the species of Polyquaternium-10. Finally, Appellants emphasize that the cited passage must be taken in the context of the full teachings of Niemiec, which indicate in col. 6, lines 39-42, that other cationic conditioning agents that are not cationic cellulose derivatives are preferred.

The Office also alleges that the ordinary artisan would have been motivated to simply add the alkyl pentoside taught by Bertho to Niemiec's composition because of its various properties. (Ex. Answer at 7.) Appellants point out, however, that the alkyl pentoside of Bertho and its properties were known to Niemiec, who did not file until well after Bertho issued. Yet, Niemiec did not list alkyl pentosides among the numerous possible surfactants for use in its composition. This omission by Niemiec underscores that one of ordinary skill in the art would not have been motivated to make the selection the Office now urges would have been obvious.

For these reasons and those of record, Appellants again respectfully request reversal of this rejection.

If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 28, 2006

By: 

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